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Applicant: Michelle Baker

Group Art Unit: 2776

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Serial No.: 09/209,162

Examiner: C. Paula

Technology Center 2100

Filed: December 10, 1998

Attorney Docket: BAK-004

Title: Electronic Mail Software with Modular Integrated Authoring/Reading Software Components

I hereby certify that this correspondence is being deposited on this day with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, PO BOX 1450, Alexandria, VA 22313-1450.

David P. Gordon

David P. Gordon

May 25, 2004

Date

Mail Stop Appeal Brief-Patents
Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

APPLICANT'S REPLY BRIEF ON APPEAL

The Examiner's Answer, paper number 25, mailed April 7, 2004, raises several new arguments to which this reply is addressed.

The Examiner on page 14 of his Answer argues that there is no support for the Applicant's conclusion that "the concept of containers is indicative of the lack of

authoring ability.” However, the Examiner’s explanation of Wolf is support itself for the statement that containers indicate the lack of authoring capability. The Examiner agrees that Wolf teaches a separate program, i.e. a full featured word processor which is used to author a server object which is viewed through the container object in the email program which does not have this authoring capability.

On page 15 of the Answer, the Examiner appears to argue that word processor programs at the time the invention was made had graphical editing capabilities. However, the argument is confusing because the Examiner states that these capabilities were provided because “wordprocessors did allow users to create graphical objects using drawing programs...”. This suggests exactly what the Applicant has argued; i.e., that a separate drawing program needed to be used to create/edit a graphic which could then be pasted into a word processing document.

On page 15 of the Answer, the Examiner makes some new arguments regarding the meaning of “other than text” at the time the invention was made without pointing to any documentary support for his interpretation. However, the meaning of terms in the appealed claims should be ascertained by what is said in the specification and by what is said by the Applicant during prosecution of the claims. See, e.g., Standard Oil Co. v. American Cyanamid Co., 227 U.S.P.Q. 293 (Fed. Cir. 1985); “The specification is the primary basis for construing the claims.”

Even though the title of the Wolf patent clearly refers to the use of a separate program, the Examiner argues on pages 15-16 that this is not necessarily indicative of what the Wolf patent actually teaches. However, the Examiner's argument again admits that it is not the email client that has authoring components but it is the (separate) word processing program that has authoring components, means for highlighting, borders, shading , etc. So, even if one ignores the applicant's intended meaning of the term "other than text", the rejection still fails to meet claim 1 because Wolf does not teach an email client having authoring components, Wolf teaches a separate word processing program having authoring components.

At page 16 of the Answer, the Examiner attempts for the first time to blur the distinction between subroutines and separate programs (by using them in the alternative - "subroutines or computer programs"), but his analysis does not alter the fact that the present inventions claims components of a single program, an email client, and Wolf teaches using a separate program in conjunction with an email client.

With regard to claims 2-4, 8-24, 26, and 27, the Examiner is of the opinion that the Applicant is estopped from making any arguments in the Brief which were not made in prosecution prior to Appeal. The Examiner argues on each of pages 16, 17, 18, 19 and 20 that the "new arguments presented in [the Appeal Brief] are conceited [sic.] since applicant did not previously raise these arguments based on the rejections addressed in paper 20." However, he cites no authority for this opinion. In paper 20, the Appellant did not believe that additional arguments were required because the independent claims

should have been allowable, and thus indicated in writing that it was unnecessary to address these specific claim rejections. In arguing that the Applicant is estopped from making reasoned arguments rather than addressing the arguments made, it would appear that it is the Examiner who is conceding that the final rejection of these claims is in fact untenable in view of these "new arguments".

In light of all of the above, it is submitted that the claims are in order for allowance, and the applicant respectfully requests that the Board direct the Examiner to allow the case.

Respectfully submitted,



David P. Gordon
Reg. #29,996
Attorney for Applicant(s)

Gordon and Jacobson, P.C.
65 Woods End Road
Stamford, CT 06905
(203) 329-1160

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